

### **REMARKS/ARGUMENTS**

Prior to entry of this Amendment, claims 9-15 and 19-32 were pending in this application. No claim have been amended, no claims have been added, and no claims have been canceled herein. Therefore, claims 9-15 and 19-32 remain pending in this application. Applicants respectfully request reconsideration of these claims for at least the reasons presented below.

#### **35 U.S.C. § 112 Claim Rejections**

The final Office Action has rejected claims 9-15 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. More specifically, the final Office Action alleges that "the specification does not disclose 'wherein determining if any first segment of the plurality of programs are not already stored and recording any first segment that is not already stored are performed before any user request for any of the plurality of programs' as amended." The Applicants respectfully submit that support for these recitations can be found throughout the specification including but not limited to Fig. 21 and 22 and the accompanying description on pages 32-34 of the description. Therefore, the Applicants respectfully request withdrawal of the rejection.

#### **35 U.S.C. §103 Rejection, Inoue**

The Final Office Action has rejected claims 9-15 and 19-32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,729,280 to Inoue et al. (hereinafter "Inoue"). The Applicants respectfully submit that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims. Therefore, the Applicants request reconsideration and withdrawal of the rejection.

In order to establish a *prima facie* case of obviousness, all claimed limitations must first be taught or suggested by the prior art. *See, e.g., DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006). The Office Action must then provide an explicit analysis supporting the rejection. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) ("a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art"). While the Office Action can use one of several exemplary rationales from the MPEP to support an obviousness rejection under *KSR*, all the rationales still require the Office Action to demonstrate that all the claim elements are shown in the prior art. *See* MPEP §2143. As will be discussed below, the reference cited by the Office Action does not teach or suggest each claimed limitation. For example, Inoue does not teach or suggest recording all first segments of a plurality of programs sent from a content provider before a user request for a program. Furthermore, Inoue does not teach or suggest program segments as recited in the pending claims or receiving or storing program segments as recited in the pending claims.

Inoue "relates to a video signal receiver for a near video-on-demand broadcast system." (Column 1, lines 7-8) In one embodiment of Inoue, "the near video-on-demand signal receiver pre-stores the first segment of a desired video program in the buffer memory apparatus." (Column 8, lines 35-38) "When a user requests reception and display of the video program, the pre-recorded segment is immediately reproduced and displayed while the receiver scans the channels carrying the program for the remaining segment of the program." (Column 8, lines 38-42) "Once a transmission of the remaining segment is found, the corresponding video signals are received, stored, reproduced, and displayed." (Column 8, lines 42-44)

That is, Inoue teaches storing a portion of a requested program that can be played out while remaining portions of the program are located and received. As noted in Inoue, "by storing a portion of a selected video program, the receiver can display the stored portion of the program while awaiting or receiving transmission from the broadcaster of a subsequent portion of the program." (Col.3, lines 60-63) However, Inoue does not teach or suggest storing a first

segment of each of a plurality of programs. In other words, Inoue does not teach or suggest storing the first segment of all of a plurality of programs. Rather, Inoue teaches storing a program that is selected in some way such as identifying a predetermined time the segment will be broadcasted, uploading the segment from a memory device, programming the device to record the program, etc. (See e.g., Col. 8, lines 49-57) Thus, only selected programs are stored, not a first segment of all programs.

In response to these arguments, the final Office Action notes that "Inoue teaches recording a first segment of a plurality of programs sent from the content provider, but not necessarily all of the programs" and argues that "one of ordinary skill in the art would recognize that this is an obvious variation of the teaching of Inoue." However, the Applicants respectfully reiterate that Inoue does not teach or suggest recording all or any first portion before a program is selected or requested by the user as discussed in detail above. Rather, Inoue teaches storing a program that is selected in some way such as identifying a predetermined time the segment will be broadcasted, uploading the segment from a memory device, programming the device to record the program, etc. For at least these reasons the Applicants respectfully contend that the rejection is improper and should be withdrawn.

Furthermore, Inoue does not teach or suggest program segments as recited in the pending claims or receiving or storing program segments as recited in the pending claims. Rather, Inoue disclose only sending an entire program on any given channel. For example, see figures 2A through 4B and the accompanying description of Inoue in which is described a program being played out in its entirety on any given channel. Upon selection of one of the programs, a first portion, e.g., a first seventeen minutes, or the program is recorded. However, this first seventeen minutes is not sent from the content provider as a first segment. Rather, it is sent as apart of the broadcast of the entirety of the program. So, for example, Inoue cannot implement a method "wherein the first digital channel does not send the second segment" as recited in new claim 28 or wherein the first segment is sent only once as recited in new claim 29. Also, Inoue cannot implement a method "wherein the first segment is sent via a first delivery

mechanism and the second segment is sent via a second delivery mechanism" as recited in new claim 31 or "wherein the first delivery mechanism comprises a cable television network and the second delivery mechanism comprises a broadband network connection" as recited in new claims 32.

Claim 9, upon which claims 10-15, 22-24, and 28-32 depend, recites in part "determining if any of a first segment of each of a plurality of programs sent from the content provider are not already stored; [and] recording any first segment of each of the plurality of programs that are not already stored, wherein determining if any first segment of the plurality of programs are not already stored and recording any first segment that is not already stored are performed before any user request for any of the plurality of programs." However, Inoue does not teach or suggest determining if any of a first segment of each of a plurality of programs sent from the content provider and recording any first segment of each of the plurality of programs that are not already stored before any user request for any of the plurality of programs are not already stored, i.e., recording all first segments. Rather, Inoue teaches pre-recording only portions of a selected programs based on identifying a predetermined time the segment will be broadcasted, uploading the segment from a memory device, programming the device to record the program, etc. (Column 8, lines 47-57.) Furthermore, Inoue does not teach or suggest program segments as recited in the pending claims or receiving or storing program segments as recited in the pending claims. Rather, Inoue disclose only sending an entire program on any given channel. For at least these reasons, the rejection should be withdrawn and claims 9-15, 22-24, and 28-32 should be allowed.

Claim 19, upon which claims 20, 21, and 25-27 depend, recites in part "recording a first segment of all of a plurality of programs sent from the content provider before any user request for the program." However, Inoue does not teach or suggest recording a first segment of all of a plurality of programs sent from the content provider before any user request for the program. Rather, pre-recording only portions of a selected programs based on identifying a predetermined time the segment will be broadcasted, uploading the segment from a memory

device, programming the device to record the program, etc. (Column 8, lines 47-57.)  
Furthermore, Inoue does not teach or suggest program segments as recited in the pending claims or receiving or storing program segments as recited in the pending claims. Rather, Inoue disclose only sending an entire program on any given channel. For at least these reasons, the rejection should be withdrawn and claims 19-21 and 25-32 should be allowed.

### **CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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